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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/692,155 10/20/00 DECOSTER

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EXAMINER

YLL.G

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

04/11/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/692,155	Applicant(s) DECOSTER ET AL.	
	Examiner Gina C Yu	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- |   |  |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 20) <input type="checkbox"/> Other:  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

3 ( The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8, 77, and 85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected because two different chemical formulas in (1) and (2)(a) are both labeled "formula (I)", rendering the claim confusing. Claims 2-6 are rejected because it lacks antecedent basis. It is unclear whether these claims refer to the R groups of the compound in (1) or (2)(a).

Claim 8 is rejected because the phrase "another polysiloxane type" is vague and indefinite. The metes and bounds of the patent protection sought are unclear.

Claim 77 is rejected because the term "satisfactory" is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 85 is rejected because the term "type" renders the claim indefinite because the claim includes elements not actually disclosed, thereby rendering the scope of the claim unascertainable.

Claim 31 is objected because of the typographical error in line 22, "wherein in".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 1-16, 70-92, 94, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. (EP 0874017) taken with Dubief et al. (U.S. Pat No. 5,679,357).

Dalle et al. teach a method of making silicone in water emulsions comprising at least one polysiloxane identical to formula (I) in claim 1 and at least one surfactant among anionic, nonionic, amphoteric, and cationic surfactants. Applicants disclose in

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specification that the silicone polymer in the instant application is described in the reference and commercially available. See spec. p.5, lines 20-21. In the reference, 9 parts by weight of polysiloxane is used, which meets claims 13-14 in the instant application. See Examples 1-3 on p. 6. The particle size of the silicone copolymer is also in the range of 0.3 – 100  $\mu\text{m}$ , which meets claims 15-16. See p. 5 , lines 35-41.

Although the reference teaches that the emulsions here can be used in bath oils, and is as useful as a delivery system for oil soluble substances, including ceramides, it lacks a specific mention that the compositions comprise a conditioner containing oil, wax, or ceramides of formula (I) in the instant application. See p. 5, lines 47-57.

Dubief et al. describe cosmetic compositions for hair or skin, which contains cationic dispersions and the ceramide and/or glycoceramides of formula (I). See col. 1, line 31 – col. 2, line 24; col. 4, line 34 – col. 7, line 48. The reference also teaches that the compositions may contain 0.005 – 15% by weight of the ceramides and/or glycoceramides, which meets claims 94 and 95. See col. 3, lines 61 – 67. Claims 70-71 are also met because the col. 4, lines 17 – 33 in the reference also discloses the additives that may be employed in the composition, and further teaches that 0.05-6% by weight of the additives may be added. The reference also teaches that the hair treatment compositions in the invention improve the disentangling of hair without lanky or greasy feel. See col. 1, lines 29-59.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions in Dalle et al. by adding the <sup>specific</sup>

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ceramides and/or glycoceramides in Dubief et al., because of the expectation to have produced cosmetic compositions for hair which improves the disentagling of hair without making the hair lank or greasy, as taught by Dubief et al. Also, it is examiner's position that the synthetic and natural oils and waxes in claims 85-92 are conventional ingredients in the art.

(B) Claims 17-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. and Dubief et al. as applied to claims 1-16, 70-71, 72-80, and 94-95 above, and further in view of Restle et al. (U.S. Pat. No. 6,039,936).

Dalle et al. and Dubief et al. are discussed above. The combined reference lacks a mention that the cationic surfactants of formula (IV), (V), (VI), & (VII) in the instant application may be employed in the composition.

Restle et al. teach cosmetic oil-in-water emulsions comprising nonionic amphiphilic lipids (silicone surfactants) and cationic amphiphilic lipids. See col. 1, lines 36 – 67. The patent describes the cationic amphiphilic lipids from the group formed by quaternary ammonium salts that meet claims 17-40 in the instant application. See col. 3, line 4 – col. 6, line 12. Examples 1 and 2 in the reference also teaches employing 1.5 % of the disclosed cationic amphiphilic lipids, which meets claims 41-43. The reference further teaches that the advantages of the compositions include an enhanced penetration of active cosmetic ingredients on hair, and glossy appearance without greasy feel and softness. See col. 1, lines 36-49.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the compositions in Dalle et al. by adding the cationic

surfactants of the quaternary ammonium salts in Restle et al. because of the expectation to have produced compositions which would enhance penetration of actives and glossy appearance, and softness on hair, as taught by Restle et al.

(B) Claims 44 - 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. and Restle et al., as applied to claims 17-42 above, and further in view of Decoster et al. (U.S. Pat. No. 6,150,311).

Dalle et al. and Restle et al. are discussed above. The combined references lack a mention that the specific surfactants in claims 44-55 may be used in the composition.

Decoster et al. describe cosmetic compositions for cleansing and conditioning keratinous materials. The compositions in the reference comprise of insoluble silicone and a washing base, which is a mixture of anionic, amphoteric, nonionic and cationic surfactants. The reference teaches that the compositions comprise 4-50% by weight of the washing base, which meets claims 43-46. See col. 1, line 1 – col. 2, line 28. The anionic surfactants in claims 47-54 are disclosed in col.2, lines 32 – 67; the nonionic surfactants in claims 56 – 58, in col. 3, lines 1-31; the amphoteric surfactants in claims 59-63, in col. 3, line 32 - col.4, line 13. The reference further teaches that the most preferred mixture of the surfactants comprise anionic and amphoteric surfactant, of which the examples are disclosed in col. 4, lines 14-38. Accordingly, claims 64-68 are rejected. The reference further teaches that 0.001 – 10% by weight of cationic polymers may be employed in the composition, which meets claim 69 and 70. See col.

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7, line 9 – col. 8, line 9. The method of using the compositions, which meets claims 72-83, are disclosed in col. 8, lines 20- 44. The reference teaches that a stable detergent composition having excellent cosmetic properties may be formulated from insoluble silicones in the washing base described above. See col. 1, line 55 – col. 2, line 5. The reference further teaches optional use of cationic surfactants, including quaternary ammonium salts and imidazoline derivatives.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the composition in Dalle et al. and added the surfactants disclosed in Decoster et al., because of the expectation to have produced stable cleansing compositions for kerataneous materials which retain the advantages of cosmetic properties of the actives, as taught by Decoster et al.

(C) Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al., Restle et al., and Dubief et al., as applied to claims 1-92 and 94-95 above, and further in view of Ramin (U.S. Pat. No. 6,099,826).

Dalle et al., Restle et al., and Dubief et al, are discussed above. The combined references lack a mention that the ceramides claimed in claim 93 may be used in the compositions.

Ramin describes the process and compositions for the cosmetic treatment of the nails which contains the ceramides in claim 93. See col. 3, lines 11 – 31. The



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reference discloses that these ceramides improves the uniformity, and the smooth and shiny nature of the outer surface of the nail.

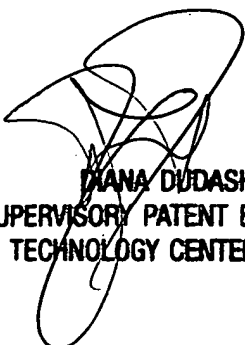
It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the compositions in Dalle et al., Restle et al., and Dubief et al., by adding the ceramides disclosed in Ramin because of the expectation to have produced compositions for nails which would enhance the uniformity, texture, and shine of the surface of the nail.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
April 8, 2001



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